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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/537,962	06/09/2005	Martin Haubner	12810-00095-US	1386

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EXAMINER

KATAKAM, SUDHAKAR

ART UNIT	PAPER NUMBER
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1621

MAIL DATE	DELIVERY MODE
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06/07/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/537,962	Applicant(s) HAUBNER ET AL.	
	Examiner Sudhakar Katakam	Art Unit 1621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 April 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of the Application

1. Receipt of Applicant's Remarks and Arguments filed on 2nd April 2007 is acknowledged. The arguments for the 103(a) rejection are not found persuasive and as such, the following rejection has been maintained. Claims 1-11 remain rejected.

Response to Arguments

2. Applicant's arguments filed on 2nd April 2007 have been fully considered but they are not persuasive.

The thrust of applicants' arguments is that **Kodama et al** fails to contain any teaching regarding determining the molecular weight and termination of the polymerization reaction. Applicants' argued that the deficiencies in **Kodama et al** are not remedied by the teachings of **Weyer et al**, and specifically **Weyer et al** do not teach or suggest adding water to the reaction mixture in order to terminate polymerization, and applicants' point to the examples set forth in the **Wayer et al**.

The examiner does not find these arguments persuasive. The examiner knew that the **Kodama et al** did not disclose applicants' process to terminate the polymerization reaction using water in order to obtain a copolymer having a desired molecular weight. However, the teachings of **Weyer et al** cure this deficiency. **Weyer et al** teach that addition of proton donor at the polyoxyalkylene chain being formed causes chain termination in the polymerization reaction [col. 2, lines 32-34]. **Weyer et al** clearly teach a process for adjusting the average molecular weight of polyoxyalkylene glycols in the heteropolyacid-catalyzed polymerization of cyclic ethers with ring

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cleavage in presence of proton donors, such as water [col.1, 12-17; col. 2, lines 32-41; col. 6, lines 4-5]. The process also produces a polymer having average molecular weight of from about 500 to 3,500 dalton [col. 2, lines 51-55].

Weyer et al also teach that the electrical conductivity can be correlated with the average molecular weight of the resulting polymer, and the value for the electrical conductivity in the reaction system can be **controlled by the addition of proton donor** [col. 3, lines 50-68; col. 4, lines 1-8]. So, with regard to the above applicants' arguments examiner direct the applicants' attention to the above teachings of **Weyer et al** in addition to the examples set forth by **Weyer et al**.

So, in view of the above explicit teachings of references, examiner finds that it would have been prima facie obvious to a person of ordinary skill in the art at the time of the invention was made, to combine the teachings of **Kodama et al** and **Weyer et al** to make applicants process, with a reasonable expectation of success of making the final product.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

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1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
5. Claims 1-11 are again rejected under 35 U.S.C. 103(a) as being unpatentable over **Kodama et al** (EP 1 361 243 A1) in view of **Weyer et al** (US 5,395,959) for the reasons of record.
6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136 (a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Correspondence


7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sudhakar Katakam whose telephone number is 571-272-9929. The examiner can normally be reached on M-F 8:30 AM - 5:00 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

S. Katakam



ELVIS Q. PRICE, PH.D.
PRIMARY EXAMINER